

### **REMARKS**

Claims 29-35 stand rejected under 35 U. S. C. §102(b) as being anticipated by U. S. Patent No. 5,567,934 to Zheng et al. ("Zheng").

According to *MPEP* §2131, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In order to expedite allowance, applicants, without prejudice or disclaimer amend claim 29 to recite additional features relating to the system having a detector separate from a recited imager for obtaining an image of the encoded indicium.

Applicants expressly reserve the right to pursue claims directed to the subject matter of claim 29 in its prior form and other prior claims in a related application (e.g., a continuing application).

Relative to a similar combination previously recited in claim 33, the Examiner relied on Zheng at column 6 and 7 as follows:

Trigger circuit 85 customarily includes an electrical energy storage device, such as one or more capacitors. Upon receipt of a signal from controller 110, trigger circuit 85 allows current to flow from such capacitors to illumination apparatus 80. Camera 40 provides a signal, representative of the light reflected from the surface, to signal processor 120.

Many variations are possible within the scope of the invention. For example, the light source illumination apparatus 80 need not be a flash lamp. Illumination apparatus 80 may include, for example, an array of light-emitting diodes, a diffuse light source, or any other type of light source. An intense light source, such as a flash lamp, is advantageous in that it will tend to minimize the influence of ambient light on the total illumination of the surface. As a result, non-uniformities in ambient illumination will contribute relatively little to total illumination. Intense illumination, such as that from a flash lamp, also permits the aperture of the camera lens to be adjusted to a minimum, to provide the greatest depth of field. Depth of field is particularly useful when a label is applied to a curved surface, such as a tube.

Shroud 20, in combination with illumination apparatus 80 and camera 40, is highly advantageous. Shroud 20, is opaque, and in operation has only bottom opening 24. As a result shroud 20 substantially eliminates the illumination of the surface by ambient light. As a result, illumination of the surface will be substantially entirely as a result of lighting apparatus 80. Thus, uniformity of illumination may be controlled. In addition, polarization of light illuminating the surface may be controlled, to reduce specular reflection. Control of the intensity of illumination is also achieved. This assures that the apparatus may successfully be used even where ambient illumination is very intense, such as in direct sunlight. The distance between the lens of camera 40 and the surface is maintained

constant, thereby eliminating the need to refocus the camera. The device according to the invention can be implemented in a hand-held configuration. *U. S. Patent No. 5,567,934, columns 6-7.*

Applicants respectfully assert that applicants cannot locate in the relied upon section of Zheng elements related to the recited combination relating to a separate detector. If the Examiner wishes to maintain the rejection of claim 29, applicants respectfully request the Examiner to point out where in the relied upon section there is a teaching relating to the recited separate detector feature. For sustaining a rejection based on anticipation, the Examiner must demonstrate that *every* claim element is present in a relied upon reference.

Regarding the claims discussed herein, the applicants' selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. In fact, it is noted in the outstanding Office action, that the dependent claims are rejected without substantial, and in certain instances, without any reference to the limitations of the dependent claims in combination with the base claim elements. Applicants expressly reserve the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

While the applicants herein may have highlighted a particular claim element of a claim for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, the applicants highlighting of a particular claim element for such purpose should not be taken to indicate that the applicants have taken the position that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present.

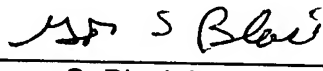
Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

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Respectfully submitted,

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